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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,188	12/15/2003	Katherine S. Bowdish	ALEX-P03-060	4387
28120	7590	04/11/2007	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			DUFFY, BRADLEY	
			ART UNIT	PAPER NUMBER
			1643	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
30 DAYS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of Non-Responsive Amendment

1. The response filed December 28, 2006, is considered non-responsive to the restriction and election requirement set forth in the Office action mailed July 26, 2006 and the amendment to the claims not been entered.

2. The response filed December 28, 2006, is non-responsive for the following reason:

Applicant received an Office action, which was mailed July 26, 2006, setting forth a restriction and election requirement.

M.P.E.P. § 818.03(a) states that the response to such an Office action must be complete; and § 818.03(b) states a complete response must include an election of an invention to be examined even though the requirement be traversed.

Then, in accordance with 37 C.F.R. § 1.143, if Applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). Nonetheless, in requesting such reconsideration, § 1.143 states the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

In this instance, the response filed did not include an election of any of the inventions originally presented in the application, and upon which the earlier Office action setting forth the restriction and election requirement is based.

Rather, the response, if entered, would cancel the originally presented claims, presenting only claims *that would have been restricted from the claims drawn to other inventions had they been presented earlier.*

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As such, contrary to Applicant's remarks, the *election* of the "invention" to which the newly added claims are directed is not a proper response to the preceding Office action¹.

Contrary to Applicant's remark, the response to the restriction and election requirement is not proper under M.P.E.P. § 818.02(a).

M.P.E.P. § 818.02(a) states, "[w]here claims to another invention are properly added and entered in the application **before an action is given**, they are treated as original claims for purposes of restriction only." In this instance, the claims that would be added, if the amendment were entered, would be added *after* an action² had been given.

Therefore, the response filed December 28, 2006, canceling all *original* claims and presenting only new claims is non-responsive to the restriction requirement set forth in the Office action mailed July 26, 2006.

3. If, at this point, Applicant would rather have the Office consider claims directed to an invention not encompassed by the originally presented claims, it is suggested that Applicant respond to this Notice by properly adding those claims³ with a request that the restriction and election requirement set forth in the Office action mailed July 26, 2006, be modified appropriately or withdrawn to be replaced by a new requirement.

The Examiner agrees to carefully consider any such request that accompanies a proper amendment filed in accordance with 37 C.F.R. § 1.121; but Applicant is reminded the reply to the present requirement set forth in the preceding Office action must still be complete with (i) an election of the invention and species (if applicable) to be examined, even though the requirement be traversed (37 C.F.R. § 1.143), and (ii) an identification of the claims encompassing the elected invention.

¹ The claims that would have been added, had the amendment been entered, are directed to a plurality of patentably distinct inventions.

² An Office "action" may include a restriction and election requirement, and need not be an action on the merits. See 37 C.F.R. § 1.142.

³ Since the claims 56-70 were not entered, claims 56-70 should be identified using the status identifier, "Not Entered", and any newly added claims should be numbered consecutively beginning with 71.

Applicant is advised that the election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other invention.

4. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brad Duffy whose telephone number is (571) 272-9935. The examiner can normally be reached on Monday through Friday 7:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully,

Brad Duffy

571-272-9935

bd

April 2, 2007

S. R.
STEPHEN RAWLINGS
PRIMARY EXAMINER
ART UNIT 1643